Attorney Docket No. 10527US16

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN THE APPLICATION OF:	**Electronically Filed on January 8, 2008**
Martin et al.	
SERIAL NO.: 09/863,722	
FILED: May 23, 2001	
FOR: IMPROVED COMPUTER JUKEBOX AND JUKEBOX NETWORK	
EXAMINER: JABR, FADEY S.	
GROUP ART UNIT: 3628	
CONFIRMATION NO.: 2165	

PRE APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

The Applicants request review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reasons stated on the attached sheets

Respectfully submitted,

Date: January 7, 2008

By: /Joseph M. Butscher/
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Attorney for Applicants

REMARKS

The present application includes pending claims 16, 17 and 20-31, all of which have been rejected. In particular, claims 16-17, 20, 22-23 and 25-26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over United States Patent No. 5,497,502 ("Castille") in view of United States Patent No. 4,949,187 ("Cohen") and United States Patent No. 6,601,159 (the "Smith patent"). Claim 27 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Castille in view of Cohen, the Smith patent and United States Patent No. 4,667,802 ("Verduin"). Claims 28-31 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Castille in view of the Smith patent. The Applicants respectfully traverse these rejections for at least the following reasons:

The Applicants demonstrate below that the portions of the Smith patent relied on by the Office Action are devoid of certain claim limitations. In particular, the portions of the Smith patent relied on by the Office Action as disclosing "compressing and decompressing song data or a user attract mode wherein song associated images are shown" do not describe, teach or suggest these limitations. Thus, the Office Action fails to establish a *prima facie* case of obviousness with respect to the pending claims.

Initially, the Applicants note that the Smith patent forms the basis for rejecting all of the pending claims of the present application with respect to 35 U.S.C. § 103. The Smith patent is a continuation of United States Application No. 08/435,125, filed May 5, 1995 (the "Smith '125

CIP"), which is a continuation-in-part of United States Application No. 07/815,217, filed December 31, 1991 (the "Smith '217 application"). *See* Smith at column 1, lines 5-8.

The '302 patent, from which the present application claims priority, was filed March 6, 1992. The filing date of the '302 patent antedates the Smith '125 CIP, but is after the Smith '217 application. Thus, in order to establish a *prima facie* case of obviousness, the Office Action needs to show that the Smith '217 application, in combination with the other cited references, discloses all of the relevant limitations of the rejected claims.

The Office Action acknowledges that "Castille **does not disclose**... compressing and decompressing song data or a user attract mode wherein song associated images are shown." *See* September 21, 2007 Office Action at pages 6, 9, 11 and 12-14 (emphasis added). In order to overcome this deficiency, the Office Action relies on the Smith patent as disclosing these limitations. *See id.* In particular, the Office Action cites the Smith patent at column 7, lines 63-66, as disclosing "compressing and decompressing video and audio data" and an "attract mode." *See id.* ("Smith teaches compressing and decompressing video and audio data to more efficiently use available storage capacity and an attract mode, see column 7, lines 63-66, to increase machine usage.").

There is nothing in the cited portion of the Smith patent, however, that describes, teaches or suggests "compressing and decompressing **song data** or a **user attract mode** wherein **song associated images are shown**." *See* November 1, 2007 Response at pages 12-13. Further, there

is nothing in the Smith patent that describes graphics that are used to attract users, or associated with songs. *See id.* Instead, the portion of the Smith patent relied on by the Office Action merely disclose that graphics may be shown during idle time, run time and warmup of a copier. *See id.* at pages 12-14. Thus, because none of the cited references describes, teaches or suggests these limitations, the combination of the references, by definition, cannot describe, teach or suggest these limitations. That is, the proposed combination of references does not describe, teach or suggest a number of claim limitations. *See id.* at pages 14-15. Thus, the Office Action has not established a *prima facie* case of obviousness with respect to the pending claims.

Additionally, the Smith '217 application does not recite the passage from the Smith patent relied on by the Office Action. *See id.* at pages 15-17. The Smith '217 application is the only application within the Smith chain of priority that antedates the filing date of the '302 patent, which is in the priority chain of the present application. *See id.* at pages 11-12 and 15. As such, the Office Action has not established that the Smith patent qualifies as prior art with respect to the limitations noted above. Thus, for at least these reasons, the Office Action has not established a *prima facie* case of obviousness with respect to the pending claims.

Further, while the final Office Action cites portions from the Smith '217 application, these cited portions do not describe, teach or suggest the relevant claim limitations. *See id.* at pages 15-17.

The Commissioner is authorized to charge any necessary fees, including the $255 fee for the Notice of Appeal and the $60 fee for the one month extension of time, or credit any overpayment to the Deposit Account of McAndrews, Held & Malloy, Account No. 13-0017.

Respectfully submitted,

Date: January 7, 2008

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